

that one skilled in the art would eventually recognize a problem with Prior Art, and if shown Ishikawa et al. and its use of coarsened surfaces to solve a problem therein, one skilled in the art would be motivated to try the same solution in Prior Art, thereby producing the claimed invention. The Examiner also acknowledged that Ishikawa et al. uses the coarsened surfaces to solve a problem that is not relevant in Prior Art.

Essentially, the Examiner argued that it would have been obvious to try the coarsening of surfaces taught by Ishikawa et al. in Prior Art.

To set forth a *prima facie* §103 rejection, there must be some evidenced reason for modifying a reference. Specifically, there must be a reference or evidence, outside of the present application, which motivates or suggests to one of ordinary skill to modify Prior Art. In addition, an "obvious to try" rationale for combining two references is not valid motivation under 35 USC §103. In re Goodwin, 576 F.2d 375, 377, 198 USPQ 1, 3 (CCPA 1978); In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); In re Tomlinson, 363 F.2d 928, 150 USPQ 623 (CCPA 1966).

Therefore, it is respectfully submitted that the outstanding rejection of claims 4-7 and 9-11 fail to set forth *prima facie* obviousness rejection. Therefore, it is respectfully requested that this rejection be withdrawn

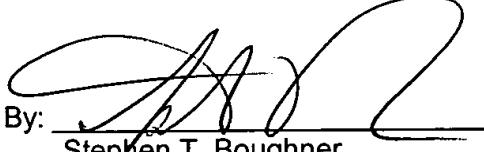
There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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